



✉ EPAEPOOE
D-80298 München
☎ +49 89 2399-0
TX 523 656 epmu d
FAX +49 89 2399-4465

Europäisches
Patentamt

Generaldirektion 2

European
Patent Office

Directorate General 2

Office européen
des brevets

Direction Générale 2

Barnfather, Karl Jon
Withers & Rogers LLP
Goldings House,
2 Hays Lane
London SE1 2HW
ROYAUME-UNI

Telephone numbers:

Primary Examiner
(substantive examination) +49 89 2399-6978

Formalities Officer / Assistant
(Formalities and other matters) +49 89 2399-0

29/1 00
KJB 24/5



Application No. 05 724 420.4 - 2413	Ref. P307478EP-PCT	Date 24.01.2007
Applicant Electronics for Imaging, Inc.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Riegler, Jörg
Primary Examiner
for the Examining Division

Enclosure(s): 6 page/s reasons (Form 2906)



Bescheid/Protokoll (Anlage)		Communication/Minutes (Annex)		Notification/Procès-verbal (Annexe)
Datum Date Date	24.01.2007	Blatt Sheet Feuille	1	Anmelde-Nr.: Application No.: 05 724 420.4 Demande n°:

The examination is being carried out on the **following application documents**:

Description, Pages

1-25 as published

Claims, Numbers

1-14 filed with entry into the regional phase before the EPO

Drawings, Sheets

1/12-12/12 as published

1 Cited Documents

The following documents (D) are referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1: US 2002/062366 A1 (ROY JOYDEEP ET AL) 23 May 2002 (2002-05-23)

D2: ANONYMOUS: "Dynamic Printer Selection system using DNS service" RESEARCH DISCLOSURE, no. 449, 1 September 2001 (2001-09-01), page 1549, XP002331192 Havant, UK, article No. 44996

2 Clarity and conciseness

The application does not meet the requirements of Article 84 EPC.

2.1 The application comprises multiple independent claims (i.e. claims 1 and 13) of the same category and therefore does not meet the requirements of conciseness, Rule 29(2).

Thus a single independent claim per category should be filed.

2.2 The wording of claim 4 appears to be incomplete and hence the subject matter for



Bescheid/Protokoll (Anlage)		Communication/Minutes (Annex)		Notification/Procès-verbal (Annexe)
Datum Date Date	24.01.2007	Blatt Sheet Feuille	2	Anmelde-Nr.: Application No.: 05 724 420.4 Demande n°:

which protection is sought is not clearly derivable from that wording.

Therefore for the assessment of novelty and inventive step, the previous wording as contained in the set of claims as published in the preceding PCT procedure (claim 13) is used for that purpose.

- 2.3 Claims 6, 7 are dependent to claim 9. This appears to be a typing error to be changed to a dependency to independent claim 4.
- 2.4 The expression "the network device is located inside the firewall" used in claim 11 is unclear, because it is not clear how one network device can be located within another network device.
- 2.5 Claim 12 is directed to a system being dependent to any preceding claim. All preceding claims, however are directed to methods. The claim is therefore unclear with respect to its category.

The same objection also applies to system claims 13 and 14, which depend upon method claim 9.

3 Inventive Step

Furthermore, the above-mentioned lack of clarity notwithstanding, the subject-matter of claims 1 and 13 does not involve an inventive step in the sense of Article 56 EPC, and therefore the requirements of Article 52(1) EPC are not met.

3.1 Claim 1

- 3.1.1 The document D1 is regarded as being the closest prior art to the subject-matter of claim 1, and discloses (the references in parentheses applying to this document):

A method (cf. cl. 5, ln. 60 - cl. 6, ln. 9) for use with a first network device (cf. '13', Fig. 5A) coupled to a first network, the first network device comprising information identifying the first network device on the first network (cf. "responder's machine address (MAC address) as well as the IP address", cl. 5, ln. 1-2), the method comprising:

- receiving an identification message from the first network device, the



Beschleid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date 24.01.2007	Blatt Sheet Feuille 3	Anmelde-Nr.: Application No.: 05 724 420.4 Demande n°:

identification message comprising the identifying information of the first network device (cf. "DLP response protocol", cl. 4, ln. 67 - cl. 5, ln. 2 and Fig. 5A);

- parsing the identification message to extract the identifying information of the first network device ("The device discovery task uses parsing functions ...", cl. 4, ln. 3-4 and "the responder's IP address ... is extracted from these response packets", cl. 4, ln. 13-15); and
- searching a directory table to identify a second network device ('14', Fig. 5A) coupled to the first network ("The device discovery task then generates ... the buffer from the information collected in the linked list", cl. 5, ln. 44-46 and "the printer 12 ... returns a web page ... with links to the other discovered printers 13 and 14", cl. 5, ln. 64 - cl. 6, ln. 1), the second network device comprising information identifying the second device on the first network (cf. "responder's machine address (MAC address) as well as the IP address", cl. 5, ln. 1-2).

3.1.2 The subject-matter of claim 1 therefore differs from this known method in that the method is applied in an environment, in which the first network coupled to a second network, for which no technical problem can be seen.

3.1.3 As the claimed method defined by the method steps does not involve said second network at all, the claim with respect to that differentiating feature is merely an aggregation and not a true combination of features providing a functional interaction between the features such that the combined technical effect different from, e.g. greater than, the sum of the technical effects of the individual features is achieved.

Connecting one network to another is however broadly known in the field of IP networks. Therefore claim 1 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT).

3.1.4 The additional features of the dependent claims do not add anything new or inventive to the independent claims, because these features are known from the above mentioned prior art (e.g. the network device comprising a printer) or common measures (i.e. network comprising a firewall).

3.2 Claim 4



Bescheid/Protokoll (Anlage)		Communication/Minutes (Annex)		Notification/Procès-verbal (Annexe)	
Datum Date Date	24.01.2007	Blatt Sheet Feuille	4	Anmelde-Nr.: Application No.: 05 724 420.4 Demande n°:	

3.2.1 Again the document D1 is regarded as being the closest prior art to the subject-matter of claim 4, and shows (the references in parentheses applying to this document):

A method (cf. cl. 5, ln. 60 - cl. 6, ln. 9) for use with first and second network devices coupled to a first network (cf. '13' and '14', Fig. 5A), the first network device comprising information identifying the first network device on the first network, the second network device comprising information identifying the second network device on the first network (cf. "responder's machine address (MAC address) as well as the IP address", cl. 5, ln. 1-2), the method comprising:

- receiving a first identification message from the first network device, the first identification message comprising the identifying information of the first network device (cf. "DLP response protocol", cl. 4, ln. 67 - cl. 5, ln. 2 and Fig. 5A "Reply");
- parsing the first identification message to extract the identifying information of the first network device ("The device discovery task uses parsing functions ...", cl. 4, ln. 3-4 and "the responder's IP address ... is extracted from these response packets", cl. 4, ln. 13-15);
- registering the first network device in a directory table according to the identifying information of the first network device (cf. "... responder's IP address is added to the list", cl. 4, ln. 64 - 65);
- receiving a second identification message from the second network device, the second identification message comprising the identifying information of the second network device (cf. "DLP response protocol", cl. 4, ln. 67 - cl. 5, ln. 2 and Fig. 5A "Reply");
- parsing the second identification message to extract the identifying information of the second network device ("The device discovery task uses parsing functions ...", cl. 4, ln. 3-4 and "the responder's IP address ... is extracted from these response packets", cl. 4, ln. 13-15).

3.2.2 The subject-matter of claim 4 differs from this known method in that it further comprises the step of searching the directory table to identify the first network device based on the identifying information of the second network device and applying the method in an environment of the first network coupled to a second network.



Bescheid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date 24.01.2007	Blatt Sheet Feuille 5	Anmelde-Nr.: Application No.: 05 724 420 4 Demande n°:

3.2.3 The problem to be solved by the present invention may be regarded as how a client connected to a first network can locate network devices connected to the same network via an external directory.

3.2.4 The solution proposed in claim 4 of the present application cannot be considered as involving an inventive step (Article 56 EPC), because the differentiating feature (item 2.2.2 above) is described in document D2 (cf. item 3. and 4.) as providing the same advantages as in the present application (i.e. discovering a network printer located on the same network as the PC). It should be noted that in D2 the netprn DNS service is integrated in a Server Printer (i.e. Print-B) which stores a table of available network printers in an equivalent way as the printer disclosed in D1 (cf. '12', Fig. 5A). The skilled person would therefore regard it as a normal option to include this feature of D2 in the method of locating and setting up a topology of network devices described in document D1 in order to solve the problem posed.

3.2.5 The additional features of the dependent claims do not add anything new or inventive to the independent claims, because these features are known from the above mentioned prior art (i.e. the network device comprising PDA, printer, etc, comprising a network interface, the network (i.e. Internet) consisting of multiple interconnected networks, identifying information is an address) or common measures (i.e. network comprising a firewall).

4 Formal objections and remarks

If the applicant intends to proceed further with the present application and is of the opinion that the application does in fact contain subject-matter that could support a patentable claim, then a new independent claim should be filed, setting out what is considered to be the inventive contribution to the art.

4.1 In his letter of reply the applicant should clearly indicate the parts of the originally filed application serving as a basis for subject-matter newly introduced into the claims. This would greatly facilitate the subsequent substantive examination of the claims with respect to Article 123 (2) EPC.

4.2 Any new independent claim should be in the two-part form recommended by Rule 29 (1) EPC having a pre-characterising portion which correctly reflects the prior art



Bescheid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date Date 24.01.2007	Blatt Sheet Feuille 6	Anmelde-Nr.: Application No.: 05 724 420.4 Demande n°:

of the cited documents D1 and D2.

- 4.3 All claims should include reference signs relating to the technical features referred to therein, Rule 29 (7) EPC.
- 4.4 The opening part of the description should be modified to bring it into agreement with any amended independent claims, Rule 27 (1) (c) EPC.
- 4.5 In order to meet the requirements of Rule 27 (1) (b) EPC, the cited documents D1 and D2 should be acknowledged and briefly discussed in the opening part of the description.
- 4.6 The vague and imprecise statement "various modifications can be made ... without departing from the scope and spirit of this invention" in the description on page 25 implies that the subject-matter for which protection is sought may be different to that defined by the claims, thereby resulting in lack of clarity of the claims (Article 84 EPC and Guidelines C-III 4.3a) when used to interpret them.